

## REMARKS

### *Interview Summary*

The Examiner (Daniel Zirker) and Applicant's representatives (Susan Yee and Colby Springer) participated in a telephonic interview on May 24, 2005 to address the outstanding rejections in the present application. Applicant and his representatives thank the Examiner for taking the time to hold the telephonic interview as Applicant's representatives believe it aided in bring certain issues into focus with the aim of bringing the claims to allowance or, alternatively, reaching a clearly defined issue for the purposes of appealing any future rejection to the Board of Patent Appeals and Interferences.

The Examiner's 35 U.S.C. § 112 rejection with regard to indefiniteness was first addressed. Applicant's representatives suggested amending the language 'first and second edges' to 'leading edge and trailing edge.' The Examiner indicated he would have no objection to such an amendment but requested that Applicant's representative provide supporting explanation of these changes in the current response. Applicant's representatives further suggested amending the language 'front and back surface'; the Examiner indicated he did not believe this language (in and of itself) to be vague and had no objection to the Applicant retaining this claim language. The Examiner further noted that he believed the claims were directed toward a kit rather than a system.

The Examiner also stated that he believed the expression of viscosity in, specifically, claim 26 to be in error. Applicant's representatives indicated they would verify the proper expression of viscosity for both the specification and the claims.

The majority of the interview pertained to the cited art of record (*Barnum, Ingle, Fumei* and *Haines*) and the Examiner's contention that the presently claimed invention is obvious in light of the same, especially the independent claims and, particularly, claim 32. The Examiner stated that he felt the claims of the present application to be obvious in light of *Barnum* and that which is known in the art. Applicant's representatives

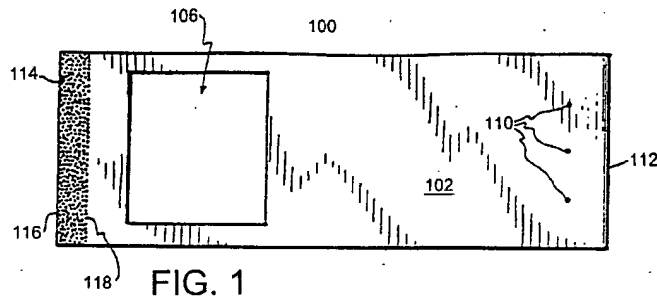
countered that there is no teaching in *Barnum* of temporary, break-away coupling as is claimed in the Applicant's invention. The Examiner, in response, contended that it was his "gut feeling" based, in part, on his experience in the 'double sided tape' art that the claimed invention is obvious. The Examiner further cited to the secondary references (*Ingle*, *Fumei* and *Haines*) as evidence of the same. Notwithstanding the Applicant's representatives noting a series of differentiating characteristics of the secondary references and the Applicant's claimed invention, the Examiner maintained his contention that temporary coupling is well known in the art. The Examiner suggested that if the Applicant submitted a Rule 132 declaration from a disinterested party countering the Examiner's contentions that the Examiner might reconsider his stance as to his obviousness rejection.

The Examiner further suggested the narrowing of the particular adhesive claimed in the present invention in an attempt to advance the application towards allowance as the Examiner believed the presently claimed embodiments to be too broad.

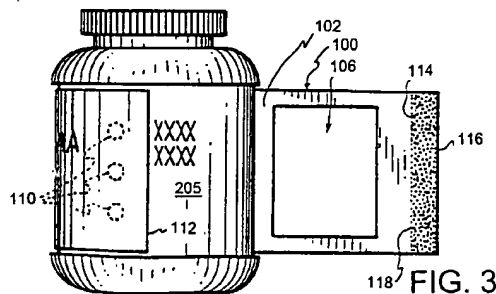
35 U.S.C. § 112, ¶ 2 Rejections

In the *Office Action*, the Examiner asserts that “[c]laims 24-26, 32-35, and 41-52 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” *Office Action*, 2 at ¶ 2.

In claim 24, the Examiner identified the Applicant’s recitation of ‘first and second edges’ and an adhesive ‘adjacent to the second edge on the back surface’ as being “vague, indefinite and confusing.” *Office Action*, 2 at ¶ 2. Applicant has amended claim 24, in part, by identifying a leading edge and a trailing edge of an outer label. A leading edge is disclosed in the specification, for example, at p. 7, l. 10 as “leading edge 112”; reference to Figure 1 (reproduced below) is illustrative.



Further reference to Figure 3 (reproduced below) is also illustrative wherein ‘leading edge 112’ is shown as the edge that is first applied to a container; leading edge 112 ‘leads’ the remaining portion of the label (100) to be applied about the container.



A 'trailing edge' is also disclosed in the specification at p. 7, l. 19 as "trailing edge 116." Reference to Figures 1 and 3 (above) is, again, illustrative. A trailing edge is the last edge applied to the container, that is, it 'trails' the remainder of the label 100.

With regard to the placement of the temporary adhesive, that adhesive may be placed in various locations on the outer label. For example, as noted in the specification, the placement may be "adjacent to a labeling edge" as is evidenced by reference 110 in Figure 3, above. *Specification*, p. 7 at l. 9. There is no particular requirement as to the exact placement of the adhesive on the outer label so long as the placement ultimately allows, for example, "for temporarily adhering the outer label 100 to the inner label 205" as is shown in Figure 3 (above). *Specification*, p. 7, l. 9-11; see also *Specification*, p. 9, l. 3-5 (preferring adhesive placement in "a sufficient amount, size, and geometry to temporarily adhere the outer label 100 to the inner label 205 while the outer label is wrapped about the container 200"). For example, the application specifically notes that "different numbers, sizes, shapes, and patterns of adhesive 110 may also be effectively employed." *Specification*, p. 9, l. 1-2.

With regard to claim 25, the Applicant has amended the claim to note that the slip agent is disposed on a portion of the container instead of the outer label. In this way, as noted by the specification, "[t]he slip agent . . . prevents [the] temporary adhesive 110 from getting into the pores of inner label front surface 272, thereby lessening the strength of the bond between surfaces 102 and 272." *Specification*, p. 8, l. 5-7. While the present discussion pertains to an inner label, the specification specifically notes that the slip agent placement also pertains to "embodiments discussed below," that is, other embodiments such as an outer label and container combination. *Specification*, p. 8, l. 4.

With regard to claim 26, the Applicant has amended the viscosity parameter to what is believed to be correct notation.

With regard to claim 32, the Applicant has made several amendments, some of which are similar in form to those in claim 24. The Applicant believes the present

amendments to claim 32—particularly with regard to a trailing and leading edge—overcome the Examiner rejections.

With regard to claim 33, the Applicant has made an amendment to reflect that the outer surface of the outer label may also have indicia disposed thereon. As noted in base claim 32, the outer surface of the inner label already has indicia disposed thereon.

With regard to the Examiner's rejection of claim 36, the Applicant notes that claim 36 has been cancelled and the rejection is, therefore, moot.

With regard to the Examiner's rejections of claims 46 and 50, amendments similar to those made above have been entered and are believed to overcome the Examiner's rejections as are rejections to any other dependent claims.

### *35 U.S.C. § 103(a) Rejections*

The Examiner contends the claims of the present invention to be "unpatentable over Barnum, Jr., taken in view of either Haines or Ingle, substantially for the same reasons of record." *Office Action*, 4. The Examiner, with regard to *Barnum*, states that "[t]he reference fails to disclose what are believed to be the relatively conventional bonding arrangements found in the applicant's claims." *Office Action*, 4. The Examiner contends that "each of the secondary references" disclose these bonding arrangements with the exception that "these labels [in the secondary references] are not rotatable." *Office Action*, 4.

The Examiner further contends that "one of ordinary skill in the art is more than capable of designing [these adhesives] to fit the required bonding characteristics, including the ability to both break a desired bond at a certain time as to enable the outer label to rotate about the inner label or container, as well as to also to be able to reaffix to the other label." *Office Action*, 4-5. The Examiner suggests that "the motivation to use such adhesives is believed to be a parameter clearly within the ordinary skill of the art in view of the artisan's desire to be able to control the outer label both during rotation and

also afterwards, i.e. to be able to both detach and then reaffix the outer label to the inner label or container.” *Office Action*, 5.

The Applicant respectfully traverses the Examiner’s contentions and asserts that a *prima facie* case of obviousness has not been established. Specifically, there is no suggestion or motivation to combine the references. See MPEP § 2142. The motivation to combine rests on the premise that the teaching or suggestion to make the claimed combination is **found in the prior art**. See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The Examiner, as previously noted, relies on the assertion that “one of ordinary skill in the art is more than capable of designing . . . the required bonding characteristics, including the ability to both break a desired bond at a certain time as to enable the outer label to rotate about the inner label or container.” *Office Action*, 4-5. The issue is not, however, whether one is *capable* of designing certain bonding techniques but rather if one of ordinary skill in the art would be *motivated* to combine certain teachings in the art to arrive at the Applicant’s claimed invention. The Applicant contends one of ordinary skill in the art would not.

First, the Examiner appears to disregard the rule that the level of skill in the art cannot be relied upon to provide the suggestion to combine the references. See *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). Additionally, the mere fact that the references “may be capable of being modified the way the apparatus is claimed” is not sufficient to establish a *prima facie* case of obviousness; “there must be a suggestion or motivation *in the reference to do so*.” *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990) (emphasis added). That is, the *reference* must exhibit the *desirability* to make the combination. The Examiner does not identify any aspect of the cited references evidencing this motivation.

The Board of Patent Appeals and Interferences has further held that a statement that modification of the prior would have been “well within the ordinary skill of the art at the time the claimed invention was made” is *not sufficient* to establish a *prima facie* case of obviousness without some *objective reason* to combine the teachings of the references. *Ex parte Levensgood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). The

Federal Circuit has held in a similar fashion finding that an obviousness rejection involving a technologically simple concept was improper because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention. See *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

Notwithstanding the legal requirements of motivation, the Applicant contends *one of ordinary skill in the art would not have been motivated to make this combination* even if they were to improperly rely solely on their knowledge and skill. The Applicant traverses the Examiner's contention through the submission of the enclosed "Declaration of David Neimuth Under 37 C.F.R. § 1.132" (*Rule 132 Declaration*). As noted in paragraphs 1 and 2 of the declaration, Mr. Neimuth is the Director of Labeling Technology for Krones Inc.—a company deemed to set the standards in the labeling field. Further, as noted in paragraph 3, Mr. Neimuth has over twenty-two years of experience in the labeling arts and, per paragraph 7, believes himself to be of ordinary skill in the art.

The *Rule 132 Declaration* specifically notes that "the state of the [labeling] art . . . prior to the filing of the present application" was lacking "labels or related machinery . . . that used a temporary break-away coupling . . . nor was anyone other than the applicant presently exploring such a coupling methodology." *Rule 132 Declaration*, ¶ 10. In fact, the *Rule 132 Declaration* notes that "no one in the art would have wanted to utilize such a temporary coupling" as it would counter the labeling paradigm of stability (*i.e.*, a permanent coupling). *Rule 132 Declaration*, ¶ 11. The *Rule 132 Declaration* further notes why a temporary coupling would have been undesirable in that the temporarily coupled label "could break free" and "becom[e] lodged in the labeling machinery" or could cause a consumer or merchandise to be injured or damaged as the result of "the slip and drop" of the container from the label. *Rule 132 Declaration*, ¶ 12. In that regard, the *Rule 132 Declaration* notes that "**no one in the art would have been motivated to use a break-away temporary coupling between an inner and an outer**

label allowing for rotation of an outer label about an inner label” as is claimed in the present application. *Rule 132 Declaration*, ¶ 13 (emphasis added).

The Examiner also appears to group all the cited references into the labeling arts. To do so understates the nature of the problem to be solved, that is, temporarily coupling an outer label to a container/inner label, that coupling subsequently being broken to provide for rotation of the outer label about the container/inner label. As noted by the Applicant, “a need exists to provide a system and method by which a *rotatable label* may be cost-effectively mounted on a container without preventing the label from being rotatable relative to the container.” *Specification*, p. 2, l. 15-17 (emphasis added).

*Barnum* offers “improvements in food containers facilitating their display, sale and use” (col 1, l. 17-18). *Ingle* is concerned with “extended, wrap around labels” (col. 1, l. 6-7). *Haines* purports to offer “a solution to [the] problems” of “supplying the necessary information to a doctor . . . and to the patient with respect to a variety of information” while remaining dedicated to “the trend toward containers becoming smaller” (col. 1, l. 29, 23-25, 17-18) while *Fumei* asserts to provide a “label that can be easily and cleanly stripped from the container for recycling” (col. 2, l. 49-51).

Notwithstanding the fact that the aforementioned references all involve labels, the Examiner explicitly states that “these labels [in the secondary references] are **not rotatable**.” *Office Action*, 4 (emphasis added). An obviousness determination requires an asserted prior art reference to be considered *in its entirety* including portions that would *lead away* from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In light of the absence of rotation in these secondary references, the Applicant contends the references to actually teach away from the Applicant’s claimed invention.

The Examiner’s subsequent statements—“to be able to both detach and then reaffix the outer label to the inner label or container”—further fail to overcome this divergent teaching. *Office Action*, 5. Detaching and reaffixing a label is not an aim of the present invention. See also *Rule 132 Declaration*, ¶ 15 (stating reaffixing a label to be



“irrelevant as the present claims do not concern the reattachment of an outer label about an inner label”).

The Applicant further notes that two patents, to which the present application makes reference, evidence the lack of temporary coupling teachings in the art. For example, in U.S. patent number 6,237,269 (to which the present application is related), the Examiner stated (in his reasons for allowance) that “[t]he prior art of record . . . alone or in combination fail[s] to teach or fairly suggest . . . removing [a temporary] coupling to permit [an] outer label to rotate about [an] inner label.” In the ‘269 Patent, the *Barnum* reference and *Fumei* reference were both considered.

Similarly, in U.S. patent number 6,402,872, from which the present application claims a priority benefit, the Examiner relied upon two patents held in the name of the present applicant for the purpose of a double patenting rejection and with regard to temporary coupling. No other novelty or obviousness rejections were made and the Examiner stated “[t]he prior art of record does not disclose or suggest . . . coupling or securing a label to an inner label or container and rotating the outer label to detach [the outer label] from the inner label or container to allow the label to rotate.” *Barnum*, *Fumei* and *Haines* were all considered during examination of the ‘872 Patent.

As such, the Applicant continues to contend that the references—either alone or in combination—fail to teach the Applicant’s claimed invention. For example, the Examiner states that “the primary reference itself [*i.e.*, *Barnum*] could almost stand alone.” *Examiner’s Interview Summary*. The Applicant respectfully traverses.

In the case of claim 24, *Barnum* does not teach a temporary adhesive being disposed on the back surface of an outer label, this temporary adhesive serving to temporarily couple the outer label to a container, nor does it teach that the breaking of this temporary coupling allows for rotation of the outer label about the container. Applicant contends that the Examiner’s assertion that *Barnum*, alone, discloses the Applicant’s claimed invention is lacking as there is: (1) no indication of coupling, (2) a temporary coupling; or (3) a temporary coupling with a temporary adhesive, the

breaking of that temporary adhesive allowing for rotation of the outer label about the container.

The combination of *Barnum* with *Ingle* still fails to teach the Applicant's claimed invention. *Ingle* describes a "wrap around label[ ]" with a surface that "possess[es] only a limited adhesion." *Ingle* at col. 1, l. 8, col. 1, l. 11-12. The purpose of this "limited adherence" is so that "said label can be *peeled away*" and subsequently "*readhered* . . . in the position in which it was formerly located after it has been *peeled away* from the front of said label." *Ingle*, col. 2, l. 32, 38-40 (emphasis added). This peel away/reapplication is not equivalent to the Applicant's claimed 'temporary adhesive disposed on the back surface of the outer label, the temporary adhesive temporarily coupling the outer label to the container . . . the breaking of the temporary adhesive allowing the outer label to rotate about the container.' While the Examiner contends that the "secondary references were essentially relied upon only to show the state of the adhesive art," merely showing the state of the art via *Ingle* still fails to teach each and every claimed limitation of Applicant's claimed invention. *Examiner's Interview Summary*.

There is no dispute as to whether the limited adhesive recited in *Ingle* (whatever that adhesive may be) existed in 1986. The issue is whether or not the particular use/configuration of those adhesives with the labeling arrangement claimed by the Applicant was in existence. Based on the absence of any reference recited under the guise of 35 U.S.C. § 102, the Applicant contends there is not. The Applicant contends such a combination of various teachings (*i.e.*, under 35 U.S.C. § 103) to also be non-existent.

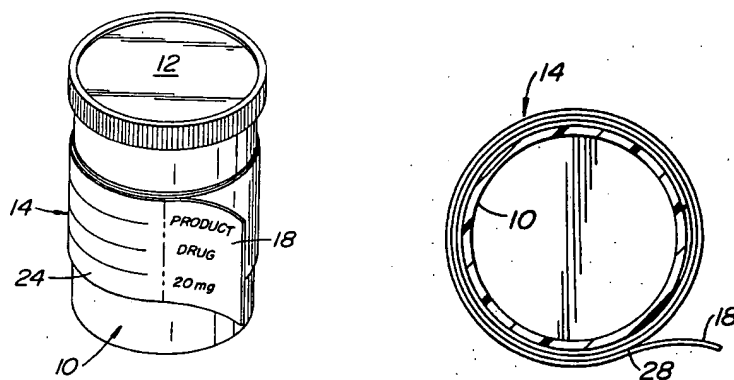
Merely peeling away a label is not that which is claimed in the Applicant's invention. The fact that the adhesive of *Ingle* allows for peel away removal and subsequent readherence suggests that the particular adhesive coupling is incapable of being 'broken' whereby an outer label may rotate about the container. If the adhesive disclosed in *Ingle* is of such adhesive strength to allow for a readherence of the removed label, then it is clearly of such strength to prevent the labels from rotating, that is, the

temporary coupling bond between the two surfaces is not broken thereby preventing rotation and contrary to that which is claimed in the present application.

Merely reciting a list of various adhesives, as the Examiner has done, does not suggest the temporary, break-away coupling as recited in the Applicant's claimed invention. The Applicant's own disclosure recites a number of adhesives. Reciting this variety of adhesives does not make obvious the Applicant's claimed invention.

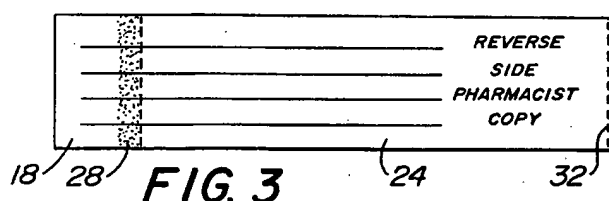
The Examiner's reliance on *Haines* also fails to teach the Applicant's claimed invention when combined with *Barnum*. *Haines* merely lists a variety of adhesives: "heat activated, water activated, pressure sensitive, etc." *Haines* at col. 3, l. 43-45. The issue, again, is not what types of adhesives exist in the art but the particular configuration and use of those adhesives as claimed by the Applicant. Notwithstanding the recitation of adhesives in *Haines*, a portion of the label is actually *removed* from the remainder of the label thereby evidencing a lack of rotation as the result of a breaking of the temporary bond.

As shown in Figures 1 and 7 of *Haines* (reproduced below), "label 14 [is] continually wound . . . around [the container 10] until the adhesive strip 28 is applied." *Haines* at col.2, l. 64-65. Adhesive strip 28 may comprise the aforementioned adhesives: heat or water activated or pressure sensitive. But again, the mere presence of these adhesives does not suggest the temporary coupling and breaking of that coupling to allow for rotation as is claimed in the Applicant's present invention.



After the application of label 14 and securing the same via adhesive strip 28, the adhesive stripe is severed thereby allowing for "unwinding the label 14 to the

perforation line 32" as shown in Figure 3 (reproduced, in part, below). *Haines* at col. 3, l. 1. "Thereafter zones 18 and 24 *are severed from the remainder of the label 14 along the perforation line 32.*" *Haines* at col. 3, l. 2-3 (emphasis added). Once severed, "the container 10 with the remainder of the label may be delivered to a patient." *Haines* at col. 3, l. 4-5. That is, there is no rotation of the label as the label has, in part, been severed from the container. That severed portion is then, as evidenced in Figure 3, retained by the pharmacist. There is absolutely no rotation of an outer label about an inner label as is claimed in the present application.



Finally, the Examiner's use of *Fumei* relies on a reference that (1) fails to evidence all the claimed limitations of the Applicant's claimed invention and (2) teaches away from the Applicant's claimed invention. As noted by *Fumei*, the bond between the label and container is such that "the label can be easily and cleanly *stripped from the container for recycling.*" *Fumei* at col. 2, l. 49-51 (emphasis added). That is, the label is meant to be removed from the container and disposed of through recycling, not rotated about the same. Furthermore, *Fumei* notes that "[t]he present invention provides" a labeling solution "*without the drawbacks accompanied by the use of hot melt adhesives glues.*" *Fumei* at col. 2, l. 36-38 (emphasis added). In that regard, *Fumei* teaches away from the Applicant's claimed invention, which uses such adhesives.

## CONCLUSION

Applicant's amendment to the specification corrects a typographical informality and does not introduce new matter.

Applicant's amendments to the claims are fully supported by the specification and further overcome the Examiner's 35 U.S.C. § 112, ¶ 2 rejections with regard to the definiteness of the claims.

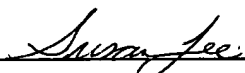
Applicant has evidenced the absence of a motivation to combine the cited references, in part, through the Rule 132 Declaration of David Neimuth. The Applicant has further evidenced the lack of every recited element in the claims. As such, the claims evidence non-obviousness over 35 U.S.C. § 103.

In light of these amendments and arguments, the Applicant respectfully requests the Examiner issues a Notice of Allowance in the present application. The Examiner is invited to contact the Applicant's undersigned representative with any questions concerning this amendment.

Respectfully submitted,  
Stephen M. Key

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